

**IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

Appl. No. : **10/014,191**
Applicant(s) : **DOBRUSSKIN et al.**
Filed : **11/13/2001**
TC/A.U. : **3714**
Confirmation : **4074**
Examiner : **SAVIC, Boris**
Atty. Docket : **PHN 16,257A**

Title: **MULTIMEDIA METHOD AND SYSTEM FOR INTERACTION BETWEEN A
SCREEN-BASED HOST AND VARIOUS DISTRIBUTED AND FREE-STYLED
INFORMATION CONTAINING ITEMS, AND AN INFORMATION CONTAINING
ITEM FOR USE WITH SUCH SYSTEM**

Pre-Appeal Brief Request for Review

Mail Stop **AF**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the final Office action of 31 January 2007, the applicants request review of the final rejection in the above referenced application. No amendments are being filed with this request. This paper is being filed with a notice of appeal.

This review is requested for the reason(s) stated on the attached sheet(s) .

REMARKS

The Examiner's omissions of one or more essential elements needed for a prima facie rejection:

Claims 4-7, 12, and 16-21 stand rejected under 35 U.S.C. 102(e) over Gabai et al. (USP 5,752,880, hereinafter Gabai). The Examiner fails to identify where Gabai teaches each of the elements of the independent claims 4 and 16.

Claims 4-7 and 12

Claim 4, upon which claims 5-7 and 12 depend, claims a method that includes receiving identity information from an item at a host in response to proximity conditions between the host and the item, and presenting to a user an associated service field at the host in response to the identity information.

The Examiner fails to identify where Gabai teaches presenting to a user a service field¹ at a host in response to the identity information, as specifically claimed in claim 4.

Claims 16-21

Claim 16, upon which claims 17-21 depend, claims a method that includes receiving identity information from an item at a host system, in response to proximity conditions between the host and the item, selecting an application program based on the identity information, the application program including one of an information processing program and an entertainment program, executing the application program at the host system.

The Examiner fails to identify where Gabai teaches selecting and executing an application program based on identity information from an item in proximity of a host system, as specifically claimed in claim 16.

¹ As background information, and without limiting the claims to this specific definition, the term "service field" includes "a particular information-related area pertaining to the item, such as a video game in which the item figures as a character, an audio story that is read from the host memory and may imply choices to be made by a listener, a video diary that may be kept and updated by the user person, and various others." (Applicants' specification, page 4, lines 1-5.)

Gabai teaches that the service field/application program is presented/executed **before** the item can be recognized, and thus cannot be said to present a service field to a user **in response to** identify information as claimed in claim 4, and cannot be said to teach **selecting** and executing a service field based on identity information as claimed in claim 16.

In Gabai, the computer is running the service field/application program, and the service field/application program recognizes the item when it is brought in proximity of the computer:

"Typically, the computer 100 runs software comprising a computer game, typically a game including at least one animated character. Alternatively, the software may comprise educational software or any other interactive software including at least one animated object." (Gabai, column 9, lines 10-14.)

Gabai illustrates an example application at FIGs. 2A-2C. At FIG. 2A, the game is running on the computer and graphic images of a clock and a bear are displayed, and controlled by the game. At FIG. 2B, the toy bear is brought in proximity to the computer. Upon detecting the toy bear, the graphic image of the bear is removed from the screen, and the game controls the toy bear instead of the image of the bear. At FIG. 2C, the toy clock is brought in proximity to the computer, and the game removes the image of the clock from the screen and controls the toy clock directly.

In response to the applicants' prior remarks indicating that Gabai teaches that the service field/application program must be running before the toy can be recognized, and thus cannot be said to teach presenting the service field in response to receiving identity information, and cannot be said to teach selecting and executing an application program based on the identity information, the Examiner states:

"the application program could be automatically launched or initiated on the start of the computer itself" (Office action, page 6, lines 7-8).

That is, in this response, the Examiner **confirms** that Gabai's service field/application program must be running before Gabai's items are identified.

The Examiner fails to specifically identify where Gabai teaches each element of claims 4 and 16. Instead, the Examiner cites the entirety of the applicants' claim 4 and follows it with a plurality of cites to Gabai, none of which teach presenting a service field, or selecting and executing an application program, in response to an item's identifying information.

MPEP 2131 states:

"A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The *identical invention* must be shown in as *complete detail* as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Board of Patent Appeals and Interferences has consistently upheld the principle that the burden of establishing a prima facie case resides with the Office, and to meet this burden, the Examiner must specifically identify where each of the claimed elements are found in the prior art:

"there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). To meet [the] burden of establishing a prima facie case of anticipation, the examiner must explain how the rejected claims are anticipated by pointing out where *all* of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection." *Ex Parte Naoya Isoda*, Appeal No. 2005-2289, Application 10/064,508 (BPAI Opinion October 2005).

The applicants respectfully note that it is the duty of the Examiner to specifically identify each and every element and limitation of a claim in the cited reference as per §1.104(c)(2) of Title 37 of the Code of Federal Regulations and section 707 of the M.P.E.P., which explicitly state that "the particular part relied on must be designated" and "the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified."

The Final Office Action is not in compliance with 37 C.F.R. §1.104(c)(2) and MPEP 707 because the pertinence of Gabai with respect each of the elements of claims 4 and 16 is not clearly explained. The goal of prosecution has not been met under MPEP 706 because the Office has not clearly articulated its rejection so that

the applicants could have the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.

The applicants stress that the Office's failure to explain how the rejected claims are anticipated by pointing out where *all* of the specific limitations recited in the rejected claims are found in the cited reference has consistently resulted in reversal of a final rejection by the Board of Patent Appeals and Interferences, as noted above in *Ex Parte Naoya Isoda*.

Because the Examiner has failed to provide a prima facie case to support the rejection of claims 4 and 16, the applicants respectfully maintain that the rejection of claims 4-7, 12, and 16-21 under 35 U.S.C. 102(e) over Gabai is unfounded, per MPEP 2131, and should be withdrawn.

Respectfully submitted,

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